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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/743,412	12/23/2003	Ikuo Kawauchi	Q79133	7933
23373	7590	03/07/2005		
SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037			EXAMINER GILLIAM, BARBARA LEE	
			ART UNIT	PAPER NUMBER
			1752	

DATE MAILED: 03/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/743,412

Applicant(s)

KAWAUCHI ET AL.

Examiner

Barbara L. Gilliam

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                                                                                         |                                                                                         |
|---------------------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                                                             | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                                                    | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>10/15/04; 12/23/03</u> . | 6) <input type="checkbox"/> Other: ____.                                                |

## **DETAILED ACTION**

### ***Priority***

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Claims***

2. Claims 1-10 are present.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-10 rejected under 35 U.S.C. 102(b) as being anticipated by Miyake et al. (EP 909 657 A2).

- a. The positive type photosensitive image-forming material for use with an infrared laser of Miyake et al. meet the present limitations for the infrared-sensitive lithographic printing plate. Specifically the positive type photosensitive image-forming material of Miyake et al. comprises a layer (A) which contains no less than 50% by weight of a copolymer which contains, as a copolymerization component, not less than 10 mol % of at least one of monomers (a-1) to (a-3) wherein monomer (a-1) has a sulfonamide group. Examples of monomer (a-1) include compounds represented by

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general formula (IV) to (VIII), all of which meet the present limitations for compound (B) ([0021]-[0023]). As copolymerization components, the monomers represented by general formula (IX) to (XI), comprising an arylene group or aralkylene group, meet the present limitations for copolymer (A) ([0024]-[0028]). Other copolymerization components include acrylates, methacrylates, acrylamide and methacrylamide monomers ([0024]). Polymer compound having a phenolic hydroxyl group, such as resole-type phenol resin, novolak-type phenol resin can be contained in layer (A) ([0029]-[0031]). According to the teachings of Miyake et al. it is necessary to add at least one of the compounds which generates heat upon absorbing light, such as dyes or pigments to the layer (B) and they may be added to layer (A) as well ([0084]-[0094]). See Examples.

5. Claims 1-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Tomita et al. (EP 1 219 464 A2)

a. The lithographic printing plate precursor of Tomita et al. meet the present limitations for the infrared-sensitive lithographic printing plate. Specifically the lithographic printing plate precursor of Tomita et al. comprises a metal support and an image-forming layer containing a light-to-heat converting agent (abstract). The thermal positive type comprises at least a high molecular compound, such as novolak type phenolic resins, copolymers comprising monomeric units represented by formula (I), (II) or (III) and copolymers comprising monomers represented by formula (IV)-(VIII) ([0121]-[0124]; [0128]). The copolymers comprising monomeric units represented by formula (I), (II) or (III) meet the present limitations for the copolymer (A). The

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copolymers comprising monomeric units represented by formula (IV)-(VIII) meet the present limitations for the compound (B). Other copolymer components include acrylates, methacrylates, acrylamides and methacrylamides ([0127]). The light-to-heat converting agent is preferably added in an amount from 5 to 40 wt% ([0222]-[0230]).

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. In US 6,573,022 B1, Miyake et al. teach a positive image-forming material for use with infrared laser.

b. In US 6,517,987 B2, Fujita et al. teach a positive-working presensitized plate useful in preparing a lithographic printing plate.

c. US 6,340,551 B1 is the US equivalent to EP 909 657 A2.

d. In US 6,143,464, Kawauchi teach a positive-working photosensitive composition for use with infrared laser.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara L. Gilliam whose telephone number is 571-272-1330. The examiner can normally be reached on Monday through Thursday, 8:00 AM - 5:30 PM.

a. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526. The fax phone

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number for the organization where this application or proceeding is assigned is 703-872-9306.

b. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Barbara L. Gilliam  
Primary Examiner  
Art Unit 1752

bg  
March 4, 2005